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| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
|---|-------------|----------------------|---------------------|------------------|
| 10/642,458 | 08/15/2003 | Suman K. Chopra | IR 7419-00 | 2143 |
| 23909 | 7590 | 07/08/2005 | EXAMINER | |
| COLGATE-PALMOLIVE COMPANY 909 RIVER ROAD PISCATAWAY, NJ 08855 | | | MOORE, MARGARET G | |
| | | ART UNIT | PAPER NUMBER | |
| | | 1712 | | |

DATE MAILED: 07/08/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

| | | | |
|------------------------------|------------------------|---------------------|--|
| Office Action Summary | Application No. | Applicant(s) | |
| | 10/642,458 | CHOPRA ET AL. | |
| | Examiner | Art Unit | |
| | Margaret G. Moore | 1712 | |

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) Responsive to communication(s) filed on 15 June 2005.
- 2a) This action is FINAL. 2b) This action is non-final.
- 3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) Claim(s) 15 to 34 is/are pending in the application.
 - 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) Claim(s) _____ is/are allowed.
- 6) Claim(s) 15 to 22, 24 to 32, 34 is/are rejected.
- 7) Claim(s) 23 and 33 is/are objected to.
- 8) Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) The specification is objected to by the Examiner.
- 10) The drawing(s) filed on _____ is/are: a) accepted or b) objected to by the Examiner.
 Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
 Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
 - a) All b) Some * c) None of:
 1. Certified copies of the priority documents have been received.
 2. Certified copies of the priority documents have been received in Application No. _____.
 3. Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date: _____ |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) Paper No(s)/Mail Date: _____ | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| | 6) <input type="checkbox"/> Other: _____ |

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1. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

2. Claims 15, 20 - 22, 24 - 26, 29 - 32 and 34 are rejected under 35 U.S.C. 103(a) as being unpatentable over WO '472 in view of Pfister et al. for reasons of record.

This rejection relies on the rationale noted in paragraph 12 of the office action dated 11/26/2004. That is, '472 fails to specifically teach a particular silicone adhesive. Thus, as the silicone PSA in '472, the skilled artisan would have been motivated to select silicone adhesives known to be useful in the medical art, particularly ones known to be useful to deliver drugs and/or active ingredients, as is necessary in '472. One having ordinary skill in the art would have been motivated to turn to the teachings of Pfister et al. to select an operable silicone pressure sensitive adhesive. Pfister et al. teach silicone PSAs that meet that found in instant claim 15 (see column 3) and this claim would have been obvious over this combination of references. See also paragraph 10 in the office action dated 3/15/2005. The PSA in Pfister et al. meets instant claims 20, 21, 30 and 31.

With regard to the amount of PSA as found in, for instance, claims 24 and 34, see paragraph 13 in the office action dated 11/26/2004 as it presently applies.

With regard to the adhesion enhancing component, this is met by the "cohesive strengthening agent" found in Pfister et al. See column 5, line 25.

For claim 25, see page 4, the last full paragraph in '472, which teaches applying the whitening strip to teeth for a period of time. One desiring to whiten their teeth would have been motivated to apply this strip multiple days to obtain an enhanced and more noticeable whitening effect.

Applicants traverse this rejection by stating that Pfister does not disclose this specific type of silicone based PSA (second full paragraph on page 7 of the response filed 6/17/05). The Examiner disagrees, and again notes column 3. Lines 30 to 45

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teach a PSA which is a condensed silicone resin and polysiloxane. Also line 65 teaches a condensed PSA. As such, the basis for this rejection is maintained.

3. Claims 16, 17 and 27 are rejected under 35 U.S.C. 103(a) as being unpatentable over WO '472 in view of Pfister et al. as applied to claim 15 above, and further in view of WO '221.

See paragraph 10 of the office action dated 11/26/2004 for the rationale behind this rejection. The Examiner notes that neither the remarks filed 12/30/04 or 6/17/05 specifically traverse the rationale behind this combination of references. As such this is maintained.

4. Claims 18, 19 and 28 are rejected under 35 U.S.C. 103(a) as being unpatentable over WO '472 in view of Pfister et al. as applied to claim 15 above, and further in view of Shiraeff.

See paragraph 11 of the office action dated 11/26/2004 for the rationale behind this rejection. The Examiner notes that neither the remarks filed 12/30/04 or 6/17/05 specifically traverse the rationale behind this combination of references. As such this is maintained.

5. Claim 23 is objected to under 37 CFR 1.75(c), as being of improper dependent form for failing to further limit the subject matter of a previous claim. Applicant is required to cancel the claim(s), or amend the claim(s) to place the claim(s) in proper dependent form. This claim fails to further limit the previous claim because reference to an adhesion enhancing agent lacks antecedent basis. The Examiner suggests amending this claim to depend upon claim 22.

6. Claim 33 is objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

The prior art fails to teach or suggest the claimed composition having the adhe-

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sion enhancing agent as claimed.

5. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

6. Claims 15 and 20 to 22 are rejected under 35 U.S.C. 102(e) as being anticipated by Lamon et al.

Lamon et al. teach silicone pressure sensitive adhesive compositions that contain a peroxide. See the teachings on column 22, starting on line 20. Particularly note line 54 and on, which teach an intercondensation product of a silanol polydiorganosiloxane and a silicone resin (meeting the silicone PSA in claim 15, 20 and 21) that contains a diaryl peroxide crosslinker. Although this composition is not described as an oral composition and Lamon et al. do not make any mention of application to a tooth, this is merely a future intended use of the composition that does not lend patentability to the adhesive composition. Note that the composition claimed is fully defined by the components in the composition. Lamon et al. fully meet each component required by the composition. As such the instant claims are anticipated by Lamon et al.

Regarding the adhesion enhancing agent, note column 23 which teaches that the PSA can be blended with other adhesives (lines 41 and on). This additional PSA can be considered an adhesion enhancing agent.

7. The prior art cited in PTO-1449 has been considered by the Examiner, including the "X" references. None of these references teach or suggest the instant claims as none teaches or suggests the silicone PSA required by claims 15 and 25.

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8. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Margaret G. Moore whose telephone number is 571-272-1090. The examiner can normally be reached on Monday to Wednesday and Friday, 10am to 4pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Randy Gulakowski can be reached on (571) 272-1302. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



Margaret G. Moore
Primary Examiner
Art Unit 1712

mgm
7/6/05